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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,847	12/04/2001	John C. Clark	57320US002	7827

32692 7590 10/18/2004

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EXAMINER	
ROBERTSON, JEFFREY	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,847	CLARK ET AL.	
	Examiner	Art Unit	
	Jeffrey B. Robertson	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it is two paragraphs long. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-9 and 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Qiu et al. (US 2003/0026997 A1).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

For claims 1, 5, 8, and 9, on page 27, paragraph [0369], Qiu teaches the reaction of $C_4F_9SO_2N(CH_3)CH_2CH_2OH$ with N-100 a triisocyanate in a ratio of 3/1, which would allow for the reaction of at least 75% of the available isocyanate groups. Note that the

amount of carbon atoms of the perfluorinated group is four. For claims 2-4, 6, and 7, paragraphs [0042] and [0106], Qiu teaches the presence of non-fluorinated monofunctional compound that can be additionally reacted up to 50 mole % of the total. This reaction would result in the compounds set forth in claim 4.

For claims 11-13, 15, and 16, on pages 11-12 in paragraphs [0132]-[0135], Qiu teaches that a treatment composition is formed from the addition of a solvent where the amount of fluorochemical present is from 1-5% by weight. Here Qiu teaches that the treatment is applied and cured, which would form a coated article. In paragraph [0138], Qiu teaches that the composition can be cured at ambient temperature. For claim 14, in paragraph [0415], Qiu teaches that the level of solids on fiber is between 0.05 to 3%.

For claim 17, Qui teaches that surfactants may be added to the composition in paragraph [0151].

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 10 rejected under 35 U.S.C. 103(a) as being obvious over Qiu et al. (US 2003/0026997 A1) as applied to claim 1 above and further in view of Boardman et al. (U.S. Patent No. 5,714,082).

The applied reference (Qiu et al.) has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the

application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

For claim 10, Qiu teaches the limitations of claim 1 as detailed above. Qiu fails to expressly teach the addition of a hydrophilic anti-staining compound as set forth in claim 10.

In paragraph [0140], Qiu teaches that conventional fiber treating agents can be used in addition to the fluorochemical composition set forth by Qiu. As detailed above, Qiu also teaches the addition of surfactants.

Boardman teaches treatment materials for fibrous substrates. See col. 1, lines 4-8. Boardman teaches in col. 6, lines 37-41, that hydrophilic anti-staining compounds can also be added.

Qiu and Boardman are analogous art because they come from the same field of endeavor, namely the use of fluorinated compositions for use in treating fibrous substrates. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional anti-staining compounds as exemplified by Boardman in the compositions of Qiu. The motivation would have been that one of ordinary skill in the art is directed by Qiu that conventional fiber-treating agents may be

added. One of ordinary skill in the art would have been motivated to increase the anti-staining effect of the composition through the addition of these compounds.

Response to Arguments

4. Applicant's arguments filed 8/2/2004 have been fully considered but they are not persuasive.

Applicant argues that the examiner ignores "a critical and necessary element of the reference", namely the fluorinated polyols set forth in Qui. Applicant further argues that one of ordinary skill in the art would not be motivated to ignore this element. In response, the examiner's position is that applicant's argument is irrelevant due to the presence of the "comprising" language in claim 1. There is no indication in the claim that the reaction product is expressly limited to the two components set forth therein. The reaction products set forth by Qui include the two named components required by applicant as set forth above. The fluorinated polyols set forth by Qui are not excluded by the claim.

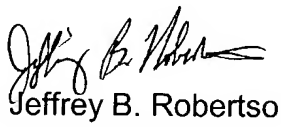
With respect to claims 2-4, applicant argues that the cited passages are not relevant because the aliphatic monofunctional compounds set forth by Qui are fluorinated. This argument is moot in view of the rejection set forth above. However, the examiner notes that there is nothing in these claims that prohibits the aliphatic monofunctional compounds from additionally being fluorinated.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR